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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,418	11/10/1999	SAID KARBASSI	M10-25447	7959

128 7590 04/26/2002

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EXAMINER

MARTIR, LILYBETT

ART UNIT PAPER NUMBER

2855

DATE MAILED: 04/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/437,418		KARBASSI ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Lilybett Martir		2855	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 November 2001.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- In claims 1 and 18 the recitation of “so that the element surface and the housing surface are substantially coplanar” makes said claim indefinite, since it is not clearly disclosed by the applicant to which plane is he referring to and to which plane are both elements are substantially coplanar (or “being largely but not wholly that which is specified” (Merriam Websters Collegiate Dictionary p. 1174)).
- In claim 25 the recitation of “so that the element surface and the external housing surface are substantially coplanar” makes said claim indefinite, since it is not clearly disclosed by the applicant to which plane is he referring to and to which plane are both elements are substantially coplanar (or “being largely but not wholly that which is specified” (Merriam Websters Collegiate Dictionary p. 1174)).
- In claim 18 the recitation of “so that the element surface and the housing surface face in a common direction” makes said claim indefinite, since it

doesn't define which common direction they share and what surfaces share said direction.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 11, 18-19, and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ip (Pat. 6,040,625). Ip discloses the claimed invention, including:

- A sensor package that includes a force sensing as in element 20 having an element surface, a housing having a housing surface as in element 40, and a well extending into the housing through the housing surface as noted in element 40 in Fig. 1, wherein the housing is arranged to support the force sensing element within the well as noted in Fig. 2, as in claim 1.
- The sensing element 20 having a thickness, wherein the housing includes a shelf as in element C, wherein the shelf supports the sensing element within the well as can be noted in Fig. 4, and wherein the shelf has a depth with respect to the thickness of the sensing element such that the element surface protrudes above the housing surface as does element 82, as in claim 2.
- The sensing element 20 having a thickness, wherein the housing includes a shelf as in element C, wherein the shelf supports the sensing element within the well as can be noted in Fig. 4, and wherein the shelf has a depth with

respect to the thickness of the sensing element such that the element surface is depressed with respect to the housing surface (Col. 1, lines 31-33), as in claim 3.

- The sensing element 20 having a thickness, wherein the housing includes a shelf as in element C, wherein the shelf supports the sensing element within the well as can be noted in Fig. 4, and wherein the shelf C has a depth substantially matching the thickness of the sensing element 20 as can be noted in Fig. 6, as in claim 4.
- Wherein the housing has a connection pad within the well as in element 32, where the sensing element has a connection pad as in element 34, where the connection pads of the housing and the sensing element are electrically coupled together when the sensing element is supported by the shelf of the housing as noted in Figure 5A, as in claim 5.
- Wherein the housing has a connection pad as in element 32, where the sensing element has a connection pad as in element 34, where the connection pads of the housing and the sensing element are electrically coupled together when the sensing element is supported by the shelf of the housing as noted in Figure 5A, as in claims 11 and 19.
- A sensor package that includes a force sensing as in element 20 having an element surface, a housing having a housing surface as in element 40, a well as noted in element 40 in Fig. 1, and first and second shelves within the well as noted in element C in Fig. 1, wherein the housing is arranged to support

the force sensing element within the well so that the element surface and the housing surface are substantially coplanar (Fig. 2), and so that the element surface and the housing surface face in a common direction as noted in Fig. 1 as in claim 18.

- Regarding method claims 25-29, said claims exist as an essential constituent of the claimed apparatus and therefore are said to be inherently disclosed in the teachings of Ip.

But he does not disclose:

- The element surface and the housing surface are substantially coplanar, as in claim 1.

Since it has been held that omission of an element and its function in a combination where the remaining elements perform the same function as before involves only routine skill in the art; In re Karlson, 136 USPQ 184; it would have been an obvious matter of design choice to modify the sensor package of IP by removing the spring element on it making the element surface and the housing surface are substantially coplanar, since applicant has not disclosed that removing the spring element solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with no spring element.

#### ***Allowable Subject Matter***

Claims 6-10, 12-17 and 20-24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed November 8, 2001 have been fully considered but they are not persuasive. Applicant's mere rearrangement of the elements of a known apparatus by removing one of the elements that comprises said apparatus is not germane of patentability. The recitation of an element that is "substantially" or "being largely but not wholly that which is specified" (Merriam Websters Collegiate Dictionary p. 1174) doesn't teach specifically how the substantially positioned elements are oriented in relation to one another as disclosed in the claims. The examiner advises the applicant that he should rephrase the rejected claims in order to obviate the 112 2<sup>nd</sup> paragraph rejections and to further clarify by amending the above rejected claims the differences between the prior art and the claimed apparatus.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lilybett Martir whose telephone number is (703)305-6900. The examiner can normally be reached on 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin Fuller can be reached on (703)308-0079. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3432 for regular communications and (703)305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

LM

Lilybett Martir  
Examiner  
Art Unit 2855

RCM  
April 22, 2002



Benjamin R. Fuller  
Supervisory Patent Examiner  
Technology Center 2800